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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Thomas L. Irving
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 06/24/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,253

Applicant(s)

GARNIER ET AL.

Examiner

Lakshmi S Channavajjala

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt of Declaration, request for extension of time, request corrected filing receipt and preliminary amendment dated 12-20-01; and IDS dated 8-14-02 is acknowledged.

Claims 1-41 are presented.

Claims

Claims 1-17 are directed to hair styling composition. Claim 18 is an aerosol device comprising composition of claim 1. Claim 19 is a method of treating hair using composition of claim 1.

Claim 20 is a method of manufacturing composition of claim 1. Claim 21 is a method of providing holding effect using composition of claim 1.

Claims 22-37 are directed to a reshapable hair styling composition. Claim 38 is an aerosol device containing composition of claim 22. Claim 39 is a method of treating hair using composition of claim 22. Claim 40 is a method of manufacturing the composition of claim 22. Claim 41 is a method of reshaping hair using composition of claim 22.

Independent claims 1, 17-22 and 37-41, directed to a composition, device or method, and require **at least one encapsulated adhesive, which comprises at least one adhesive encapsulated by at least one encapsulating material.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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1. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,071,706 to Soper or US 3,691,270 to Charlie et al (Charlie).

Instant claim 1 requires at least one encapsulated adhesive, which comprises at least one adhesive encapsulated by at least one encapsulating material. Claim 2 recites a cosmetically acceptable carrier. Claim 4 requires that the encapsulating material be made of film-forming materials. Soper discloses a microcapsule, the shell of which is made of gelatin/carboxymethyl cellulose and a core material, containing oil that is encapsulated by the shell (abstract, col. 2, lines 35-61 and claim 1). The core also contains an emollient (claim 2). The shell component of Soper reads on the claimed film-forming material. The core material containing oil or emollient of Soper read on instant adhesive. Further, claim 1 recites aqueous formulations containing the microcapsules containing water and hence reads on claimed carrier (instant claim 2).

Charlie discloses a cosmetic makeup removing or treating composition, which is microencapsulated and the compounds used for forming the capsule wall include starch esters, polyvinyl polymers, cellulose derivatives (col. 2, lines 51-65). The cosmetic makeup materials of Charlie include cosmetic products for hair application (col. 3, lines 26-31). Further, examples of Charlie recite components such as Vaseline, gum, oils etc., which read on the instant adhesive. The compositions of Charlie recite water, which is a cosmetically acceptable carrier as claimed.

Instant claim 1 recites "hair styling composition" in the preamble, which does not carry patentable weight. Accordingly, Soper or Charlie et al anticipate instant claims.

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2. Claims 1-5 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,089,269 to Noda.

Noda discloses a composition containing microcapsules, the wall of which is made of gelatin film or other polymers including starch derivatives, xanthan gum, and other synthetic polymers (col.2, lines 1-68). In particular, example 30 is directed to hair cream oil containing liquid paraffin, microcrystalline wax, which read on instant encapsulated adhesive because the paraffin and wax adhere to hair, encapsulated by gelatin and gum arabic capsules and further contain other additives like fragrance, benzyl benzoate and also an aqueous phase. Thus, Noda anticipates instant claims.

Claim Rejections - 35 USC § 103

3. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/00105 to Schofield in view of Noda.

Schofield teaches hair styling compositions comprising organic adhesive polymers, ethoxylated alcohol and solvent such as water. The adhesive polymers of Schofield include the claimed cationic, anionic, nonionic and amphoteric polymers (page 2, last paragraph). In particular, the polymers described on pages 8-9 (formula on page 9) reads on instant polymers of claims 11 and 12. Further, Schofield teaches up to 10% by weight of the polymers, which is within the claimed range (claim 15). Schofield teaches the composition for styling hair which provides flexible and good hold film texture, without compromising the ability to re-arrange hair (reshapable). Schofield also teaches the composition in the form of mousses, gels, sprays and comprising additionally a propellant and spray dispenser (page 2 & page 25). Thus, Schofield teaches an aerosol form of the composition. Schofield further teaches hair styling conditioner,

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solvents and additives on pages 21-24. Schofield does not teach the claimed Fmax and Es.

However, absent showing evidence to the contrary, polymers of Schofield possess the claimed Fmax and Es values.

Schofield fails to teach encapsulation of adhesive polymers, as claimed.

Noda, discussed above teaches encapsulation of cosmetic components in capsules formed from gelatin, which reads on instant film-forming material. Noda teaches encapsulating cosmetic materials such hair conditioners, mascara; eyeshadow, skin conditioning and other skin and hair care components (col. 1-2, col. 9, lines 10-44). It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to encapsulate the hair styling composition of Schofield comprising polymeric adhesive, ethoxylated alcohol, solvent and other hair styling components in the gelatin or other suitable material because Noda teaches that the capsules enclosing the cosmetic materials impart excellent stability to the unstable water-soluble or insoluble cosmetic substances and yet can be easily applied to skin or hair without the feeling of a foreign matter upon application. Noda further suggests that separate but simultaneous encapsulation of several cosmetic substances is also possible by their method. Accordingly, by preparing the hair styling composition of Schofield in the form of encapsulated polymers one of an ordinary skill in the art would have the expected a stable composition that can be applied without a heavy feeling (due to capsulation) and yet obtain hair styling effects that are flexible to rearrangement (i.e., reshaping as taught by Schofield).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-71 of U.S. Patent No. 4,548,051. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant hair styling composition comprising encapsulated polymeric adhesives encapsulated by an encapsulating material are of the same scope as that of the patented claims. In particular, the patented claims recite the same polymer adhesives and same methods. The patented claims recite that the adhesive particle contains a substrate that is at least partially coated. In other words the claims include partial coating as well as complete coating (which is the same as encapsulation). Accordingly, it would have been obvious for one of an ordinary skill in the art to either partially coat or completely encapsulate the polymeric adhesive particle (having same F_{max} and E_s as claimed in the instant) and still expect to achieve an effective hair shaping or styling or reshaping effect.

The use of several trademark compounds has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Lakshmi S Channavajjala
Examiner
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June 23, 2003